

Remarks

Claims 1-31 were pending in this application. Claims 3 and 23 were rejected under 35 U.S.C. § 112, ¶ 2 for indefiniteness for the use of trade names in the claims. Claims 1, 2, 4, 5, 10, 13, 14, 19, 20 and 29 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,943,432 to Biener. Claims 3, 6, 9, 11, 12, 16, 18, 23 and 24 have been rejected under 35 U.S.C. § 103(a) as obvious over Biener in view of U.S. Patent No. 5,425,954 to Thompson et al. Claims 15-17, 21 and 22 are rejected under 35 U.S.C. § 103(a) as obvious over Biener in view of the *Handbook of Cosmetic Science and Technology*. Claims 25-26 are rejected under 35 U.S.C. § 103(a) as obvious over Biener in view of JP 08-113530 to Kyotaro et al. Claims 27, 28, 30 and 31 were rejected under 35 U.S.C. § 103(a) over WO 97/16155 to Riklis in view of Biener. Claims 2, 7-9, 11, 14, 20 and 25-31 have been canceled.

Summary of Invention

Applicants' invention is directed to a composition that is not disclosed or taught in any of the cited art. In particular, Applicants' invention is directed to a *clear* gel using *actual* Dead Sea water, a *hydrophobic* agent and a *non-ionic solubilizer*. Applicants have made the discovery that the addition of a non-ionic solubilizer will prevent the salting out that is expected when high salt concentration water (*i.e.*, Dead Sea water) is combined with a hydrophobic agent. No cited art addresses this problem or teaches Applicants' solution.

Rejection under 35 U.S.C. § 112, ¶ 2

Claims 3 and 23 have been amended to recite the chemical names for the trade names "tween-20", "tween-80", "oleth-20" and "oleth-80". The chemical names are as set forth in the

International Cosmetic Ingredient Dictionary, vol. 1, 1993. Applicants respectfully submit that the Examiner's rejections of claims 3 and 23 have been overcome.

Rejections under 35 U.S.C. § 103(a)

Obviousness requires that each and every element of a claim be present in a combination of references, along with a teaching, motivation and suggestion of success in combining them. *See MPEP § 2143.01.* A modification to a reference is not obvious if it changes that reference's principle of operation. *MPEP § 2143.01.* In addition, a modification to a reference that renders the reference unsatisfactory for its intended purpose is not obvious. *Id.* In addition, the motivation to combine reference must be "clearly and particularly" taught in the references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Finally, in determining obviousness, the Examiner "cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies." *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

1. Use of Actual Dead Sea Water Is Not Taught

Here, none of the cited art discloses a clear gel made of Dead Sea water, a hydrophobic active agent and a non-ionic solubilizer. First, Biener teaches away from using actual Dead Sea water, teaching instead a solution having *some* of the salts present in Dead Sea water. (*See* Biener, col. 1, l. 42-col. 2, l. 9; col. 2, l. 44-49). A reference that teaches away from an invention vitiates any argument for obviousness based on that reference because the teaching, motivation and suggestion of success is lacking. *See MPEP § 2141.02* (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)). Here, the use of the composition disclosed in

Biener would necessarily (and, according to Biener, advantageously) omit certain trace elements found in Dead Sea water, the unique combination of which provides beneficial effects, e.g., U, Th, V, Rb, Pb, Ni, Mo, Mn, and Cu. Thus, rejections based on a combination with Biener cannot stand.

2. The Prior Art Does Not Teach A Clear Gel With The Claimed Combination Of Ingredients

The composition of the present invention comprises two components which are completely missing from Biener: a non-ionic solubilizer and a hydrophobic active agent.

A composition containing hydrophobic agents in the presence of high electrolyte, concentration such as that typical of Dead Sea water can be obtained in the form of oil-in-water emulsion. Such composition, which contains micron size oil droplets, has a white color, due to light scattering from the large emulsion droplets compared to the visible light wavelength and differences in refractive indexes. Therefore, what could have been expected from the use of Dead Sea water and hydrophobic agents, mixed in the cosmetic preparation of the invention was a turbid, non-clear gel, which is aesthetically and commercially unappealing.

Thompson et al. concerns a composition comprising Vitamin E or Vitamin A, both being hydrophobic active agents. However this publication does not concern preparations having such a high salt content as those present in actual Dead Sea water so that the problem of “salting out”

was never encountered by this teaching. Furthermore, Thompson et al did not attempt to obtain a clear gel.

The inventors of the present application were faced with a unique problem: on the one hand they wished to create a clear gel composition which has a strong aesthetic appeal in the cosmetic field. On the other hand, the inventors wanted to use two components (high salt water and hydrophobic agents) which when mixed together have a clouding, non-transparent, effect.

Actual Dead Sea water having a very high salt concentration, and mixed with a hydrophobic active agent, such as for example a vegetable oil, or a hydrophobic vitamins result in a non-transparent agent. Applicants were challenged by the attempt to maintain transparency while combining these two components. This unique problem was solved by choosing the correct solubilizer, namely, a non-ionic solubilizer.

Enclosed is a Declaration by Prof. Shlomo Magdassi, one of the inventors of the present application, which demonstrates the immediate loss of transparency caused when a ionic (cationic or anionic) solubilizers are added to Dead Sea water and the maintenance of transparency when non-ionic solubilizers are used..

Biener did not face this problem when wishing to prepare his “transparent gel,” as in Biener there is no hydrophobic agent and thus there is no problem of “clouding” and loss of transparency.

The Thompson et al. publication also did not face this problem of loss of transparency, as this publication is not concerned at all with transparent or clear gels, so turbidity or transparency was not an issue. Furthermore, this publication does not concern water having a high salt content, such as Dead Sea water .

Applicants' solution to the unique problem of maintaining transparency in a composition having a very high salt content on the one hand and a hydrophobic agent on the other hand, while eliminating the problem of "clouding over," was resolved by adding a non-ionic solubilizer. As can be seen in the attached Declaration by Prof. Magdassi, only the addition of such a non-ionic solubilizer solved the problem of clouding over.

None of the prior art publications cited are even concerned with the problem of maintaining a clear gel composition which contains those two non-compatible components – *i.e.*, water with a very high salt content on the one hand, and a hydrophobic agent on the other hand. The present invention was able for the very first time to provide a clear gel for cosmetic purposes, a gel having the legendary beauty component of natural Dead Sea water, as well as additional hydrophobic agents which are very beneficial to the skin, such as various vegetable oils and vitamins, and combine these two in a unique preparation that maintains its appealing transparent properties.

Accordingly, claim 1 and 5 are not obvious over any of the cited art.

Because claims 1 and 5 are patentable, claims 3, 4, 6, 10, 12, 13, 15-19 and 21-24 are patentable as dependant from patentable base claims. *See* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Applicants respectfully submit that the amendments herein demonstrate Applicants' preference for particular language and, notwithstanding anything to the contrary, are not intended to be amendments related to patentability. Furthermore, Applicants respectfully submit that the amendments herein merely add language of equivalent scope, and that nothing herein is intended to narrow the scope of any of the claims.

The Commissioner is hereby authorized to charge any additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 13-0019. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and such fee should also be charged to our Deposit Account.

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